

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 2 of 6

Remarks

Claims 1-20 are currently pending.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 16, and 18-20 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Relyea (U.S. Patent No. 4,594,276).

Applicant respectfully traverses the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the art (*ATD Corp. v. Lydall, Inc.*, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998)).

Applicant submits that Relyea does not disclose, teach, or suggest the present invention. For example, Relyea does not disclose, teach, or even suggest reusable adhesive body apparel that comprises an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal therefrom, as recited in claim 1, and the claims dependent therefrom. In other words, Relyea does not disclose, teach, or even suggest adhesive body apparel that is reusable.

The Examiner points to column 2, line 1 to column 3, line 58, and column 4, lines 32-39 for the disclosure of an uneven surface topography, wherein the medical grade tape material used is reusable and is removable without pain to the wearer and with the adhesive laminated to the tape material.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 3 of 6

Applicant has extensively reviewed Relyea, and respectfully disagrees that the reference discloses a material that is reusable. Applicant submits that the acrylic adhesive specifically disclosed by Relyea is not reusable. Indeed, one of the other references identified by the Examiner, (Felton et al. (U.S. Patent No. 6,207,874)), actually indicates that the tattoos disclosed by Relyea are removed with baby oil or rubbing alcohol (see, Felton et al. column 3, lines 32-33). The use of baby oil or rubbing alcohol reduces the adhesive properties of Relyea's tattoos and makes them non-reusable. Therefore, Relyea's tattoos are not reusable, or do not comprise an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal the body surface, as recited in the present claims.

In view of the above, Applicant submits that Relyea does not teach each and every limitation recited in the present claims, and therefore, the present claims, and claims 1-3, 16, and 18-20 in particular, are not anticipated by Relyea under 35 U.S.C. § 102. In addition, applicant submits the present claims are unobvious from and patentable over Relyea under 35 U.S.C. § 103.

Rejections Under 35 U.S.C. § 103

Claim 4 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Felton et al. (U.S. Patent No. 6,207,874). Claims 5 and 17 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Limburg et al. (U.S. 6,604,854). Claims 6, 7, 12, 14, and 15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Applicant's Own Disclosure of Known Adhesives. Claims 8-11 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Dodge (U.S. Patent No. 6,371,831). Claim 13 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Dodge and Applicant's Own Disclosure of Known Adhesives.

Applicant respectfully traverses the rejections.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 4 of 6

Applicant submits that a *prima facie* case of obviousness has not been established. For example, the Office Action fails to indicate where in the prior art, a suggestion or motivation is provided to modify the teachings of references to obtain the claimed apparel. Absent such an indication, applicant submits that the rejections under 35 U.S.C. § 103 cannot be maintained. The motivation or suggestion to support a rejection under 35 U.S.C. § 103 must be clear and particular (*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added), and "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (*In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). Applicant respectfully submits that the prior art fails to provide a clear and particular showing that one of ordinary skill in the art would have been motivated to modify the teachings of the references to obtain the claimed apparel. Absent such a clear and particular indication, the rejections under 35 U.S.C. § 103 cannot be properly maintained.

In addition, even if the prior art included a motivation or suggestion to combine the references, which applicant does not concede, the combinations of references fail to disclose, teach, or even suggest all of the limitations of the amended claims. For example, the combinations of references fail to disclose, teach, or even suggest reusable adhesive body apparel that comprises an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal the body surface.

For example, the Office Action fails to indicate where in the prior art, a suggestion or motivation is provided to combine the teachings of any of the references to obtain the claimed apparel. Regarding the rejection of claim 4, the Office Action does not state that there is any motivation or suggestion to combine Relyea and Felton et al. (page 3 of the Office Action). The rejections of claims 5 and 17 similarly include no indication where in the prior art a suggestion or motivation is provided to combine the teachings of Relyea and Limburg. Regarding the rejections of the claims in view of Applicant's Own Disclosure, Applicant respectfully submits that the Examiner has not provided any evidence that the material disclosed by Applicant is actually prior art to the present invention. Applicant respectfully requests the Examiner to

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 5 of 6

provide evidence supporting the Official Notice and to point out where a motivation or suggestion is provided to combine that with Relyea or any other reference. Absent such evidence and an indication, Applicant respectfully submits the rejections must be withdrawn.

Thus, Applicant submits that a person of ordinary skill in the art would not be motivated to combine any of the references as proposed by the Examiner.

In addition, even if the references could be properly combined, which Applicant does not concede, the combinations of references fail to disclose, teach, or suggest all of the limitations of the present claims. For example, the combinations of references fail to disclose, teach, or even suggest reusable adhesive body apparel comprising an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal the body surface, as recited in the present claims.

The primary reference, Relyea, fails to disclose, teach, or even suggest the apparel as recited in the present claims. Applicant submits that Relyea actually teaches away from the present invention because Relyea specifically discloses that the adhesives are similar or identical to the acrylic adhesives used on surgical tapes, and as confirmed by Felton et al., such adhesives are removed with baby oil or rubbing alcohol, as discussed above. Thus, Applicant submits that Relyea discloses tattoos that are only used once, and actually teaches away from reusable apparel because the adhesives are removed with oils or alcohols. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994))

In view of the foregoing remarks, Applicant respectfully submits that the claims present claims, and claims 1-20 in particular, are unobvious from and patentable over the combination of references under 35 U.S.C. § 103.

In conclusion, Applicant has shown that the present claims are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore,

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 6 of 6

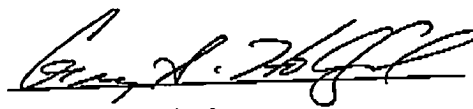
Applicant submits that the present claims, that is claims 1-20 are allowable. Accordingly, Applicant requests the Examiner to pass the above-identified application to issuance at an early date.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned representative invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

Date: _____

6/14/04



Greg S. Hollrigel
Registration No. 45,374
Stout, Uxa, Buyan & Mullins, LLP
4 Venture, Suite 300
Irvine, California 92618
Telephone: 949-450-1750